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09/589,666

1 33. (original) The system of Claim 6 further including:
2 a proxy server associated with said browser for
3 transmitting proxy condensed versions of Web HTML documents
4 to personal palm-type computers, and

5 means for overriding said proxy servers to thereby
6 permit the accessing by said palm-type computers of said
7 second set of natural language data conveying said second
8 version of condensed displayable data.

1 34. (original) The method of Claim 11 including the further
2 steps of:

3 normally providing a condensed version of Web HTML
4 documents to personal palm-type computers, and

5 overriding said proxy servers to thereby permit the
6 accessing by said palm-type computers of said second set of
7 natural language data conveying said second version of
8 condensed displayable data.

REMARKS

The claims have been amended to more clearly define the present invention over the new combination of references applied by Examiner. Claims 1-3 and 19-22 have been cancelled. Accordingly, the rejection of remaining amended claims 4-18 and 23-34 under 35 U.S.C. 103(a) as being unpatentable over Kikinis (US6,076,109) in view of Donoho et al. (6,604,109) is respectfully traversed. Every claim in this Application requires the transmission of a markup language document such as a Hypertext Markup Language (HTML) document containing two versions of the data content: a first version of the content which is displayable at standard display stations, and a condensed version of the same data content displayable on smaller palm-type displays.

AUS920000234US1

11

PATENT
09/589,666

While Kikinis recognizes the need to condense data content of HTML documents to fit smaller personal device displays, Kikinis does not provide the two versions in a single HTML document. Rather, in the Kikinis system, when the smaller hand-held device requests a copy of a particular HTML document, the requested document, instead of being routed through the conventional Web server (23, Fig. 4), is routed through a proxy server (19) wherein the document content is reduced or condensed so as to fit the confines of the hand-held display. Thus, the Kikinis HTML documents only contain one version which is subsequently condensed to another version in the proxy server 23 when there is a request from a hand-held computer. On page 3 of the current Office Action, the Examiner agrees with Applicants that this is the primary shortcoming of the Kikinis patent i.e. it:

"...does not disclose that the two sets of natural language are combined and contained within the same markup language document file."

However, Examiner looks to the teaching of Donoho (6,604,109) to make up for this deficiency of Kikinis. Donoho does not disclose this claimed element. In addition, the claims have been amended to define a further aspect of the present invention which Donoho does not suggest; means in the personal palm-type computer for directly accessing the second i.e. condensed version of the displayable data from the received markup language document.

The Donoho patent is a very extensive description (100 columns and 26 pages of drawing relative to how information broadcast over the Web or Internet may be selectively scanned, chosen, organized, summarized, and, of course, tailored to meet

AUS920000234US1

12

PATENT
09/589,666

the specific needs of users referred to as Advice Consumers of clients. This is carried out by a sophisticated system of intelligent servers which serve as agents for the advice consumers. In this extensive general disclosure which is not related to the present invention, the Examiner has extracted a segment at col 22, lines 15-22 which appears to only be pertinent if interpreted in light of Applicants' own teaching. There is a general statement of an E-mail message with alternative versions the selection of which is determined by the destination. When read in the light of Donoho's teaching, this only means that Donoho's interpretive servers can select the appropriate version suitable to the needs of the advice consumer. There still is no suggestion of the element of the present invention wherein there are means in the personal palm-type computer for directly accessing the second i.e. condensed version of the displayable data from the received markup language document.

Applicants submit that such a proposed combination of references is being made not with the requisite foresight of one skilled in the art, but rather with the hindsight obtained solely by the teaching of the present invention. This approach cannot be used to render Applicants' invention unpatentable.

What the Examiner has done is used Applicants' disclosure as a guideline, and the picked and combined elements from each of the Kikinis and Donoho references based solely of Applicants' teaching.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its

AUS920000234US1

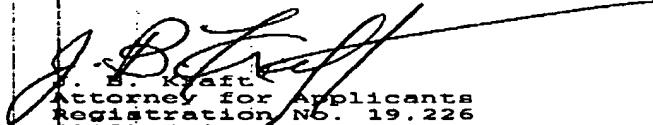
13

combining Kikinis with Donoho in the manner proposed by the Examiner could only come from Applicants' own teaching, and, thus, cannot form any basis for a combination of references.

Claims 4-8, 10-13, 15-18, 20, 22, and 24 include the further elements of a first and a second set of tags in each HTML document respectively identifying the two data set versions of the same content. Kikinis or Donoho contain nothing equivalent to such identifying tags.

In view of the foregoing, claims 4-18 and 23-34 are submitted to be in condition for allowance, and such allowance is respectfully requested.

Respectfully submitted,


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AUS920000234US1

14